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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,042	11/12/2001	Guy Middleton	1320.06	6099

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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

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DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,042

Applicant(s)

MIDDLETON, GUY

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: original application filed 11/12/2001, with foreign priority date of 5/13/1999. IDS filed 1/28/2002 (as paper 4).
2. Claims 1-13 are pending. Claims 1, 8, 10 are independent.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 5/13/1999. It is noted, however, that applicant has not filed a certified copy of said application as required by 35 U.S.C. 119(b).

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Compression And Decompression Of Browser Executable Documents.
5. Claims 1-13 are objected to because of the following informalities: Applicant's claim numbering must be modified to reflect USPTO standards. Although bracketed paragraph numbering of the specification (i.e. [0001], etc.) is acceptable according to MPEP 8th Ed. Rev. 1, section 608.01 – pages 600-54 to 600-55, section “Paper Requirements” item (b)(6)), this does not, however, extend to the claims. In particular, each claim number should be followed by a period, and should not contain brackets or letters. In addition, the beginning of each claim should be indented accordingly, and each element or step of a claim should be separated by a line indentation (see also MPEP 8th Ed. Section 608.01(m) – page 600-69. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In regard to independent claims 1, 8, 10, the phrase “*the most commonly occurring segments*” in each of said claims is vague, subjective, and indefinite. The scope of said phrase is not defined, since it is unclear how many times a segment must be present before said segment is deemed “commonly occurring”.

In regard to dependent claims 2-7, 9, 11-13, claims 2-7, 9, 11-13 are rejected for fully incorporating the deficiencies of their respective base claims, as explained above.

In additional regard to dependent claims 12, 13, The use of trademarks “JavaScriptTM”, and “YB Script”TM”, in claims 12 and 13 has been noted.

The trademarks above are used as a limitation to identify a software application, therefore the claims do not comply with the requirements of 35 U.S.C. 112, *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claims’ scopes are uncertain since the trademarks cannot be used properly to identify any particular material or product, such as the version of the software application being referred to be the trademarks. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark in a claim to identify or describe a material or a product would not only render a claim indefinite, but would constitute an improper use of the trademark.

In additional regard to dependent claim 13, in addition to the above, the term “YB Script TM” is vague and indefinite. The examiner has never heard of this type of scripting language, and cannot find support in Applicant’s disclosure in support of this (it is noted that Applicant defines “VB Script TM” on specification page 4 line [0011], however, please see rejection regarding trademarks, above).

Examiner’s Note

The following rejections are based upon a possible interpretation of “commonly occurring segments”, as segments present in a document, and “JavaScript TM”, “YB Script TM”, as scripting languages.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **The claimed invention (as defined by claims 1-13) are directed to non-statutory subject matter.**

In regard to independent claims 1, 8, 10, the combined limitations within each said claim can be interpreted as a series of mental and/or manual steps (i.e. mentally examining a document, and revising its code strings using pencil and paper, etc.), therefore said claims are directed towards non-statutory subject matter.

The examiner’s suggestion of changing claim 1 (preamble) to read “*A computer executable compression method...*”, changing claim 8 (preamble) to read “*A computer executable compression string...*”, and changing claim 10 (preamble) to read “*A computer executable expansion technique...*”, will overcome this rejection.

In regard to dependent claims 2-7, 9, 11-13, claims 2-7, 9, 11-13 are rejected for fully incorporating the deficiencies of their respective base claims, as explained above.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind et al. (hereinafter Hind), U.S. Patent No. 6,635,088 filed November 20, 1998, issued October 21, 2003.

In regard to independent claim 1, Hind discloses compression/decompression (via replacement of tags) of a tag based (i.e. XML, SGML, etc.) file comprising text, said file intended to be processed and displayed by a browser (Hind Abstract, column 4 lines 1-15, 22-32, column 8 lines 51-59, column 9 lines 31-40, column 12 lines 48-51; compare with claim 1 “*A compression method for compressing a file containing tags, information, and code constituted of simple text readable and/or executable by a browser program for display therein, said technique comprising the steps of...*”).

Hind discloses analyzing said file for strings related to entity declarations. An entry in a table of strings is created and incremented accordingly (Hind column 10 lines 7-18, 67 to column 11 lines 1-15; compare with claim 1 “*analyzing the file for the number of instances of particular segments of text...*”).

Hind discloses replacing tags in a file with references, as well as a look up string table for replacement of entity references (tags, etc.) when said file is expanded (i.e. tags used for controlling layout, etc.) (Hind

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column 8 lines 45-55, column 9 lines 30-40, column 10 lines 64-67 to column 11 lines 1-15) (compare with claim 1 “*replacing the most commonly occurring segments with....during subsequent expansion of the compression string.*”).

In regard to dependent claim 2, Hind discloses a final (i.e. repackaged) document comprising replacement of tag pairs </Order> with , etc. (Hind Figures 7A and 7B).

In regard to dependent claim 3, Hind discloses a look up table stored and/or transmitted along with a compressed file (Hind column 14 lines 49-52).

In regard to independent claim 8, claim 8 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 9, Hind discloses replacing tags in a file with references, as well as a lookup string table for replacement of entity references (tags, etc.) when said file is expanded (i.e. tags used for controlling layout, etc.) (Hind column 8 lines 45-55, column 9 lines 30-40, column 10 lines 64-67 to column 11 lines 1-15).

In regard to independent claim 10, claim 10 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 11, Hind discloses decompression software integrated into an application that processes compressed XML and SGML files (said processing typically including displaying of said files) (Hind column 7 lines 50-58).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-7, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind, as applied to claim 1, above, and further in view of Bodin et al. (hereinafter Bodin), U.S. Patent No. 6,604,106 filed December 10, 1998, issued August 5, 2003.

In regard to dependent claim 4, Hind teaches an XML parser routine in the form of utility modules for decompressing strings (Hind's column 7 lines 50-59). Hind does not specifically teach said routine in the form of an inserted browser executable expansion routine (within the document) for decompressing said strings. However, Bodin teaches decompressing document content via an inserted Java applet (Bodin column 4 lines 22-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Bodin's applet code to Hind's code blocks, providing Hind the benefit of an applet routine for clients lacking specialized decompression support.

In regard to dependent claim 5, Hind teaches that various names can be used for substitution purposes, therefore the definitions can be interpreted as variable (Hind column 11 lines 58-67).

In regard to dependent claim 6, Hind teaches code blocks containing initialization/termination tags, as well as various lookup components and strings (Hind Figure 7B).

In regard to dependent claim 7, Hind discloses compression/decompression (via replacement of tags) of a tag based (i.e. XML, SGML, etc.) markup file, said file intended to be processed and displayed by a browser (Hind Abstract, column 12 lines 48-51).

In regard to dependent claims 12, 13, Hind teaches an XML parser routine in the form of utility modules for decompressing strings (Hinds column 7 lines 50-59). Hind does not specifically teach said routine in the form of an inserted script for decompressing said strings. However, Bodin teaches decompressing document content via an inserted Java applet (i.e. using a scripting language) (Bodin column 4 lines 22-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Bodin's applet script to Hind's code blocks, providing Hind the benefit of an applet routine for clients lacking specialized decompression support.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bodin et al.	U.S. Patent No. 6,311,223	issued	10-2001
Ross	U.S. Patent No. 6,163,780	issued	12-2000
Murashita et al.	U.S. Patent No. 5,854,597	issued	12-1998

Antoshenkov, Gennady, Dictionary-based order-preserving string compression, ACM VLDB Journal, Volume 6, Issue 1, February 1997, pages 26-39.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (703) 305-9792.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).



William L. Bashore
Patent Examiner, AU 2176
May 2, 2004